

REMARKS

Applicant's representative is filing under authority of 37 C.F.R. §1.34.

Applicant thanks the Examiner for acknowledging receipt of office action response filed 4/29/2009.

Applicant notes that the Office identifies claim 31 as missing from the listing of claims and the status is unclear. The Office also states claims 1-31 are pending from amendment filed 7/3/2008, but does not state claims 32-38 added in amendment filed 4/29/2009 are pending although reference is later made to them. To overcome any ambiguity and further prosecution, Applicant has provided a newly numbered claimset of the claims already present in the application. Applicant has also provided cross references between claim numbers as used in the current Office Action of 7/9/2009 and those presented in this response.

Newly numbered claims 39-75 are pending in the application. Claims 39-75 correspond to the claims presented in the amendment filed 4/29/2009. Note that previously pending claim 31 was a duplicate of claim 30, and independent claim 21 originally entered in Preliminary Amendment A dated 9/9/2004 is not included. No new matter is added.

Claims 1-31 (now 39-68) are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully submits that claims 1-31 (now 39-68) as explained herein comply with the written description requirement of 35 U.S.C. §112, first paragraph.

Claims 1-6, 8-14, and 16-38 (now 39-44, 46-52, and 54-75) are rejected under 35 U.S.C. §103(a) as being unpatentable over Blume (U.S. 2004/0023200). Claims 7 and 15 (now 45 and 53) are rejected under 35 U.S.C. §103(a) as being unpatentable over Blume (U.S. 2004/0023200) in view of Williams et al. (U.S. 5,899,700). Applicant respectfully submits that the claims, as supported by the previous amendments and arguments herein, are distinguishable from the cited references.

Drawings

Applicant thanks the Examiner for accepting the Drawing submitted on 28 May, 2004.

IDS

The Information Disclosure Statement filed 4/29/2009 has been placed in the application file, but was not considered as failing to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. No copy of International Application Number PCT/IB2004/003802 has been provided. Applicant has presently submitted an Information Disclosure Statement including a copy of PCT/IB2004/003802 (also designated International Publication Number WO/2005/093553). Applicant has also submitted a copy of EP0359541 and Applicant's related granted patent GB2428505.

CLAIM AMENDMENTS

While renumbered, claims have not been amended in this response. For convenience and to further prosecution, among the amendments made in the response of 4/29/2009 are the following. Claim 1 (now 39) was amended to include "of a medium player". Claims 1, 8, 9, 10, 20 and 23 (now 39, 46, 47, 48,

58, and 61) were amended to include “but in no fixed xy location(s) on the page(s)”. Claims 1, 3, 4, 5, 9, 11, 12, 13, and 16 (now 39, 41, 42, 43, 47, 49, 50, 51, and 54) were amended to replace “wand” with “transmitter”. Claims 1, 7, 15, and 32 (now 39, 47, 53 and 69) include “including identification of the selected (book) passage(s), identification of the (corresponding) selected track, and a control signal instruction for the transmitter to signal playback (of the selected track)”. No new matter is added.

Claim Rejections – 35 U.S.C. §112

The Office has quoted the statute from 35 U.S.C. §112 first paragraph, which is referenced herein.

The Office has rejected claims 1-31 (now 39-68) under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Office states “The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added claim limitation of printing coded indicia on pages of a book, “but in no fixed xy location on the pages” is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” This phrase is present in current independent claims 39, 46, 47, 48, 58, and 61.

Applicant respectfully disagrees. Applicant argues that “xy location” is understood to mean x and y coordinates referring to a unique numeric value for each of a horizontal distance along a page and a vertical distance perpendicular to the direction of the horizontal distance. In two dimensions on a page of displayed text, this defines a point. A fixed value for this point designates an invariant location on a page. In contrast, Applicant’s coded indicia location is “fuzzy”, not relying on a unique point location.

Applicant's specification repeatedly discloses that the location of the coded indicia is merely "on the margin or free space of the book in apposition to or near the specific passage(s) text material, the specific subject matter" (¶[0011]). In other words, the indicia have no fixed xy location with respect to the text passage for which supplemental material exists. The xy location of Applicant's coded indicia provide no information, but serve to flexibly provide a visual cue to the reader of which text passage is associated with a coded indicium (see Figure 1 and at least ¶[0017]).

The Office further rejected claims 1-31 (now 39-68) under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically: "It is unclear how one would print coded indicia on pages of a book "but in no fixed xy location on the pages", since printed indicia on a substrate is inherently fixed and not capable of being moved." Applicant agrees that once printed in a paper and ink book, coded indicia are fixed and not capable of being moved. However, at the time of printing the printer is not required to locate coded indicia at any specific point location. Similarly, for an electronic screen display, no xy pixel location is necessitated for Applicant's coded indicia (see at least ¶¶[0009] and [0017]).

Applicant has carefully considered the Office rejection and respectfully submits that claims 1-31 (now 39-68) comply with the written description requirement of 35 U.S.C. §112, first paragraph.

Claim Rejections – 35 U.S.C. §103

The Office has quoted the statute from 35 U.S.C. §103(a), which is referenced herein.

The Office Action rejects claims 1-6, 8-14, and 16-38 (now 39-44, 46-52, and 54-75) under 35 U.S.C. §103(a) as being unpatentable over Blume (U.S. 2004/0023200; hereinafter Blume).

The Office Action rejects claims 7 and 15(now 45 and 53) under 35 U.S.C. §103(a) as being unpatentable over Blume in view of Williams et al. (U.S. 5,899,700; hereinafter Williams). Applicant has carefully considered the Office §103(a) rejections and respectfully submits that the claims, as supported by the arguments herein, are distinguishable from the cited references.

According to the MPEP §2143.01, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art."

A useful presentation for the proper standard for determining obviousness under 35 U.S.C. §103(a) can be illustrated as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue;
3. Resolving the level of ordinary skill in the pertinent art; and
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by an examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

The Board of Patent Appeals and Interferences (BPAI) continues to reverse Examiners that can not explain "why a person of ordinary skill in the art would have found it obvious" to combine the references in the manner proposed

by the Examiner.” The Applicant notes that none of the references specifically recognized the advantages discussed in the present application.

Further, “...[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See Lee*, 277 F.3d at 1343-46; *Rouffett*, 149 F.3d at 1355-59.” *In re Kahn* (Fed. Cir. 2006, 04-1616).

“...[T]o establish a prima facie case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. [*Rouffett*, 149 F.3d at 1355] In practice, this requires that the Board “explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.” *Id.* at 1357-59. This entails consideration of both the “scope and content of the prior art” and “level of ordinary skill in the pertinent art” aspects of the Graham test. When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used *hindsight* to conclude that the invention was obvious.” *In re Kahn* (Fed. Cir. 2006, 04-1616).

Therefore, in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. (*see* USPTO Memo May 30, 2007 from Margaret A. Focarino, Deputy Commissioner for Patent Operations)

The Office Action rejects claims 1-6, 8-14, and 16-38 (now 39-44, 46-52, and 54-75) under 35 U.S.C. §103(a) as being unpatentable over Blume.

Particularly, regarding claims 1, 8, 9, 20-21 and 24 (now 39, 46, 47, 58-59, and 62), the Office states that “Blume discloses a system and method for supplementing the materials of various passages of different printed book descriptive materials, with visual and supplemental materials, related to the specific subject matter of the passages of printed descriptive materials (see ¶20)...”. Neither in ¶20, nor elsewhere, does Blume disclose Applicant’s system and method. In ¶20 Blume discloses “a system that provides audio and/or video output from printed matter-books, magazines, etc. – that are printed on special paper.” Blume defines this special paper as “a substrate having a substantially invisible, machine-readable coordinate grid.” (See ¶10). Blume’s title “System for Enhancing Books with Special Paper” reinforces this permanent focus of the Blume reference on developing a substrate for an invisible page grid and reader for its detection. While Blume does disclose audio and/or video output, Blume’s machine-readable coordinate grid is not Applicant’s claimed code indicia.

The Office continues, “...that comprises, electronically storing on tracks of a recorded storage medium pluralities of the visual and audio supplemental information (See ¶ 34)...”. However, Blume ¶34 does not mention tracks at all. In contrast, Blume ¶34 discloses the “inflexible” approach of information storage that is “permanent (i.e. the database in ROM), though such a configuration is somewhat inflexible.” Furthermore, ¶34 discloses a multistep process of: 1) connecting to an additional device, 2) finding a database, 3) downloading the identified and located database into RAM, and final processing by an associated microprocessor. This is not Applicant’s claimed direct passage-correlated track storage on a player. (See Applicant’s description of player and tracks stored thereon in at least ¶20, ¶22 and Figure 1.)

Next, the Office states “...and each provided with accessing coding specific to each such track of the medium; printing on the pages of the book alongside each of the various descriptive material passages, and an electronically readable code indicia corresponding specifically to that coded track of the medium containing the recorded specific visual/audio supplemental material (see ¶ 28)...”. Blume’s ¶28 returns to the “substantially invisible, machine-readable coordinate grid”, providing a description of its operation. Particularly, “As the ultraviolet lamp is drawn over the page, the coordinate grid is exposed and “read” (i.e. detected) by the optical scanner.” Continuing, this signal is “...interpreted by the output device 16 (of Blume Figure 1) to determine the coordinate location on the page, which designates the corresponding content of the page, and allows retrieval of that content from the database of information.” Blume’s access additionally requires the preceding steps of 1) identifying the book being read and 2) identifying the page whose grid is being exposed and read. This is in distinct contrast with Applicant’s direct “identification of the selected book passage, identification of the corresponding selected track, and a control signal instruction for the transmitter to signal playback of the selected coded track...” through the single act of reading a coded visible indicium.

Continuing, the Office cites Blume for “...providing an electronic wand 14 for remotely selectively accessing the respective tracks of a medium player available to the book reader, and controlling the visual/audio playing of the same for displaying/reproducing to the reader said supplemental visual information recorded on the respective tracks; and further providing to the book reader an electronic reader (optical scanner 34) of said coded indicia, adapted to actuate the electronic wand to playback respective coded tracks of the medium in the player in accordance with the book reader applying the electronic indicia reader to the respective code indicia in the book (See ¶ 23-24), thereby

providing the book reader with audio/video supplemental material while reading.” As mentioned in the previous Response paragraph, Blume’s multiple steps (that are required) to access output are disclosed in detail in Blume ¶¶23-24 cited by the Office. These are completely different from Applicant’s claimed accessing. Furthermore, Blume’s x-y grid actuation at its essence requires identification of values for x and y on the page surface for its operation. (See Blume ¶25, ¶31, ¶33, ¶39, and ¶40). Applicant’s system in further distinction uses coded indicia in “fuzzy” locations, not relying on a unique xy grid point location. As mentioned above under the §112 discussion, Applicant’s specification repeatedly discloses that the location of the coded indicia is merely “on the margin or free space of the book in apposition to or near the specific passage(s) text material, the specific subject matter” (Applicant’s ¶11 plus ¶¶7, 8, 17, and 20). In other words, the indicia have no fixed xy location with respect to the text passage for which supplemental material exists. The xy location of Applicant’s coded indicia provide no information, but serve to flexibly provide a visual cue to the reader of which text passage is associated with a coded indicium (see Applicant’s Figure 1 and at least ¶17).

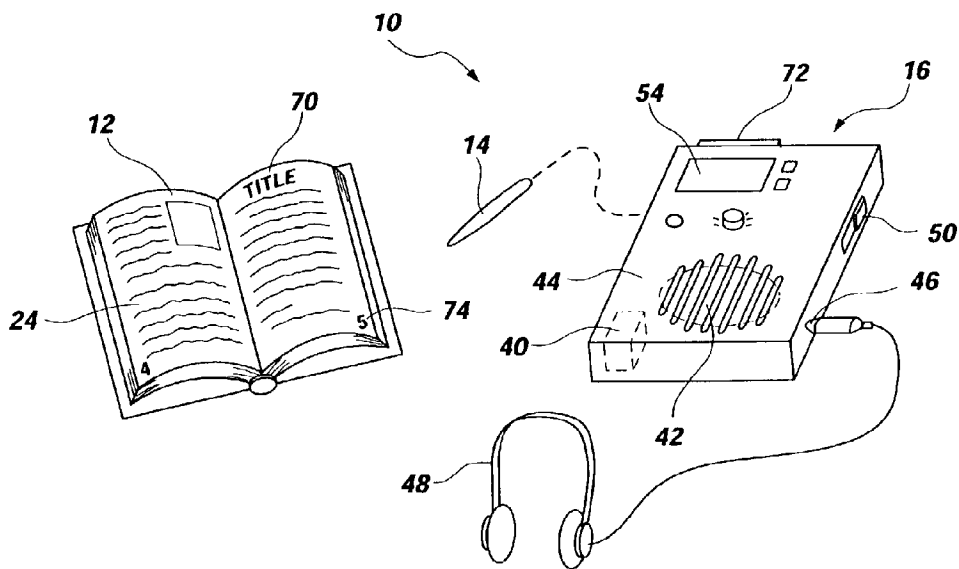
The Office correctly states that “Blume does not explicitly disclose that the electronically readable track identifying code indicium is in no fixed x/y location on the pages.” However, Blume ¶28 and ¶32 are cited to suggest “that the electronically readable code indicia should be applied in the book to the unprinted margins or spaces of the book pages near the corresponding printed passages.” As previously mentioned, here Blume describes a fluorescing page grid and scanning methods. Paragraph 28 expounds on the physics of fluorescing ink, never disclosing the use of blank page areas. Nor does ¶32 mention margins or spaces. Although codes are mentioned in Blume’s ¶32, the codes (preferably invisible), are not at unprinted regions, but specifically at printed locations such as for the title (Fig. 1, 70) and page numbers (Fig. 1, 74).

This is not Applicant's claimed indicia positioning in no fixed xy location on the pages.

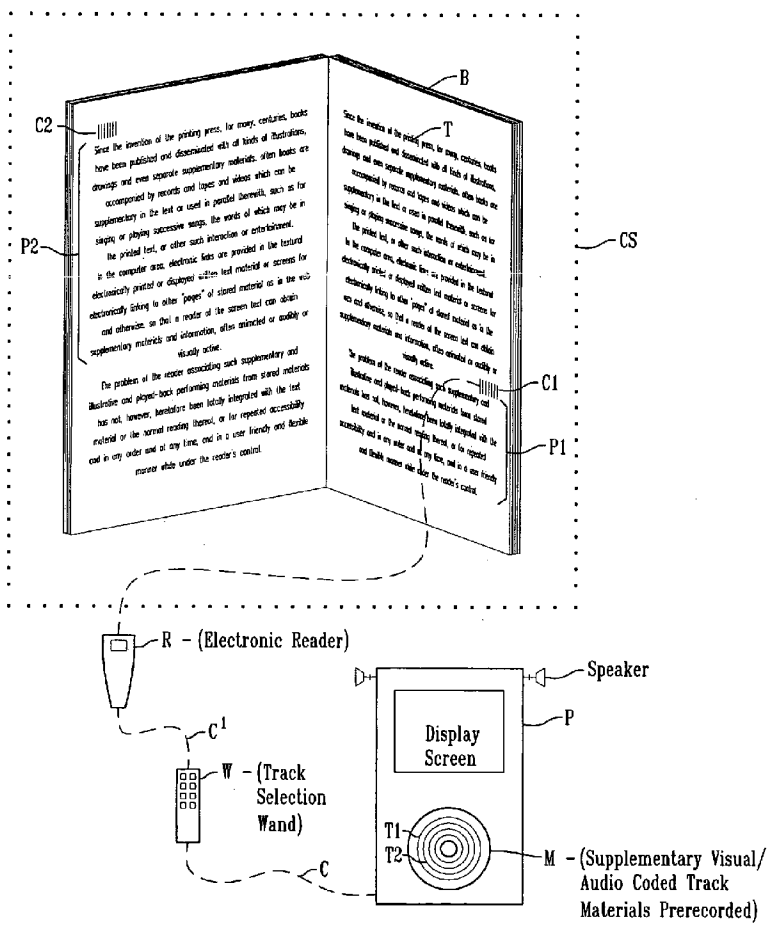
Nevertheless, the Office states "Thus, Blume does not limit the location of the readable code indicia to one particular position. Therefore, it would have been obvious to one of ordinary skill in the art to modify the readable code indicia described in Blume by locating them in various x/y locations in book pages, in order to correspond the cod indicia to a particular passage."

It would have violated Blume's objective of using virtually invisible grids to place Applicant's conspicuous, visible, coded indicia on the pages. Furthermore, modification of Blume by incorporating coded indicia in margins or spaces would not produce Applicant's invention providing "an electronic indicia reader of the contents of said coded indicia, including identification of the selected book passage, identification of the corresponding selected track, and a control signal instruction for the transmitter to signal playback of the selected coded track...".

Blume's Figure 1 and Applicant's Figure 1 are provided below to assist understanding of Applicant's distinctions. .



Blume Figure 1 (above)

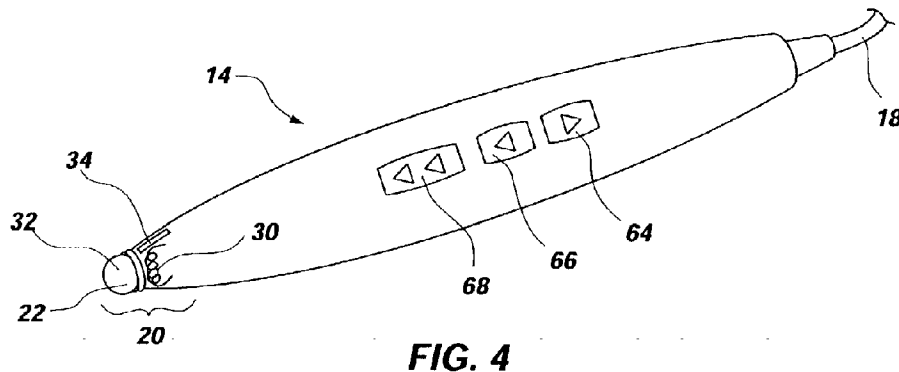


Applicant Figure 1 (above)

Quoting the Office, “Regarding claims 2 and 10 (now 40 and 48), Blume discloses electronically readable code indicia applied in the book to the unprinted margins or spaces of the book pages near the corresponding printed passages. (See ¶28, 32).” Please see previous discussion regarding Blume ¶28 and ¶32 distinctions.

Quoting the Office, “Regarding claims 3 and 11 (now 41 and 49), Blume discloses a method wherein the book reader's application of the electronic code indicia reader 34 to a selected book coded indicia automatically actuates the wand 14 in turn to actuate the player to select and play the respective recorded track on the medium corresponding to the book reader's selected book indicia. See ¶23-24.” Please see previous discussion regarding Blume ¶23 and ¶24 distinctions.

Quoting the Office, “Regarding claims 4 and 12 (now 42 and 50), Blume discloses a portable, hand-held electronic reader 34 in wired communication with the wand 14, and the wand is in wired, remote or wireless communication with the player. See ¶21.” Although Blume ¶21 does mention a wireless stylus 14 of Figure 1, Blume's stylus 14 as further disclosed in Blume's ¶28 could not provide Applicant's communication with the player. Blume's sole pointing device or stylus 14 is depicted in Figure 4 below. Blume's purpose (from ¶10 particularly) is to use written material where “The reading material is printed on a substrate having a substantially invisible, machine-readable coordinate grid.” Blume's optical scanner 34 works in conjunction with Blume's ultraviolet lamp 32 to sense invisible grids patterned on a page. Nowhere does Blume employ, teach, or disclose an electronic reader in communication with a wand/transmitter that is in communication with the player as claimed by Applicant. Applicant's components are shown in Applicant's Figure 1 above.



Blume Figure 4 (above)

Quoting the Office, “Regarding claims 5 and 13 (now 43 and 51), Blume discloses an electronic reader 34 and wand 14 that are integrally packaged. See Fig. 4.” While Blume discloses a single stylus, as described above, it can not perform Applicant’s claimed functions.

Quoting the Office, “Regarding claims 6 and 14 (now 44 and 52), Blume discloses an electronic reader 14 provided with the book 12. See Fig. 1.” Please see Blume stylus 14 discussion above and previous discussion regarding claims 1 and 9 (now 39 and 47) from which claims 6 and 14 (now 44 and 52) depend.

Quoting the Office, “Regarding claim 16 (now 54), Blume discloses that the reader 34 and the wand 14 are packaged in the form of a hand-held stylus. See Fig. 4.” Applicant respectfully submits that Claim 16 (now 54) recites “The apparatus of claim 50 wherein either the electronic reader alone or the reader and transmitter are packaged in the form of a hand-held tool. Again, please see Blume stylus 14 discussion above and previous discussion regarding claim 9 (now 47) from which claim 16 (now 54) depends.

Quoting the Office, “Regarding claims 22 and 25 (now 59 and 62), Blume discloses that the reader communication to the player of reader-selected indicia is effected by the reader initiating electronic reading of the indicia and communication thereof to the player. See ¶23-24.” Please see previous discussion regarding Blume ¶23 and ¶24 distinctions.

Quoting the Office, “Regarding claim 23 (now 60), Blume discloses that the player is remote from the reader and the communication is wireless. See ¶21 and 37.” Please see Blume stylus 14 discussion above and previous discussion regarding claim 20 (now 58) from which claim 23 (now 60) depends.

Quoting the Office, “Regarding claim 26 (now 63), Blume discloses that the indicia reading is effected by electronic scanning by the written material reader. See ¶23-24.” Please see previous discussion regarding Blume ¶23 and ¶24 distinctions.

Quoting the Office, “Regarding claim 27 (now 64), Blume discloses a storage medium playback system that is remote from but visible to the reader of the written material, and the communication thereto is wireless. See ¶21 and 37.” Please see previous discussion regarding claim 24 (now 62) from which claim 27 (now 64) depends.

Quoting the Office, “Regarding claims 28 (now 65), Blume discloses a storage medium comprising CD, CD player and display screen 54. See ¶35.” Please see previous discussion regarding claim 24 (now 62) from which claim 28 (now 65) depends.

Quoting the Office, “Regarding claim 29 (now 66), Blume discloses various storage medium systems, including DVD. See ¶35.” Please see previous discussion regarding claim 24 (now 62) from which claim 29 (now 66) depends.

Quoting the Office, “Regarding claim 30 (now 67), Blume discloses wherein the storage medium playback system comprises computer-accessible web storage and display screen. See ¶37.” Please see previous discussion regarding claim 24 (now 62) from which claim 30 (now 67) depends.

Quoting the Office, “Regarding claim 31 (now 68), Blume discloses wherein the storage medium playback system comprises a computer 40 with internal storage and playback capability upon a display screen 54. See ¶34.” Please see previous discussion regarding claim 24 (now 62) from which claim 31 (now 68) depends.

Quoting the Office, “Regarding claim 17 (now 55), Blume discloses a longitudinal shaped tool 14, but does not explicitly state that the tool is storable with the book. However, it is the examiner's position that it would have been obvious to one of ordinary skill in the art to store stylus 14 described in Blume with the book, since the book and stylus are utilized together.” Please see previous discussion regarding claim 9 (now 47) from which claim 17 (now 55) depends.

Quoting the Office, “Regarding claim 18 (now 56), Blume discloses a hand-held tool that is connected by a cord to the book.” Please see previous discussion regarding claim 9 (now 47) from which claim 18 (now 56) depends.

Quoting the Office, “Regarding claim 19 (now 57), Blume discloses a tool that is detachably connectable to the book. See ¶21.” Please see previous discussion regarding claim 9 (now 47) from which claim 18 (now 57) depends.

Quoting the Office, “Newly added claims 32-38 are rejected for the same reasons set forth in the rejection of claims 1-6, 8-14, and 16-31.” Similarly,

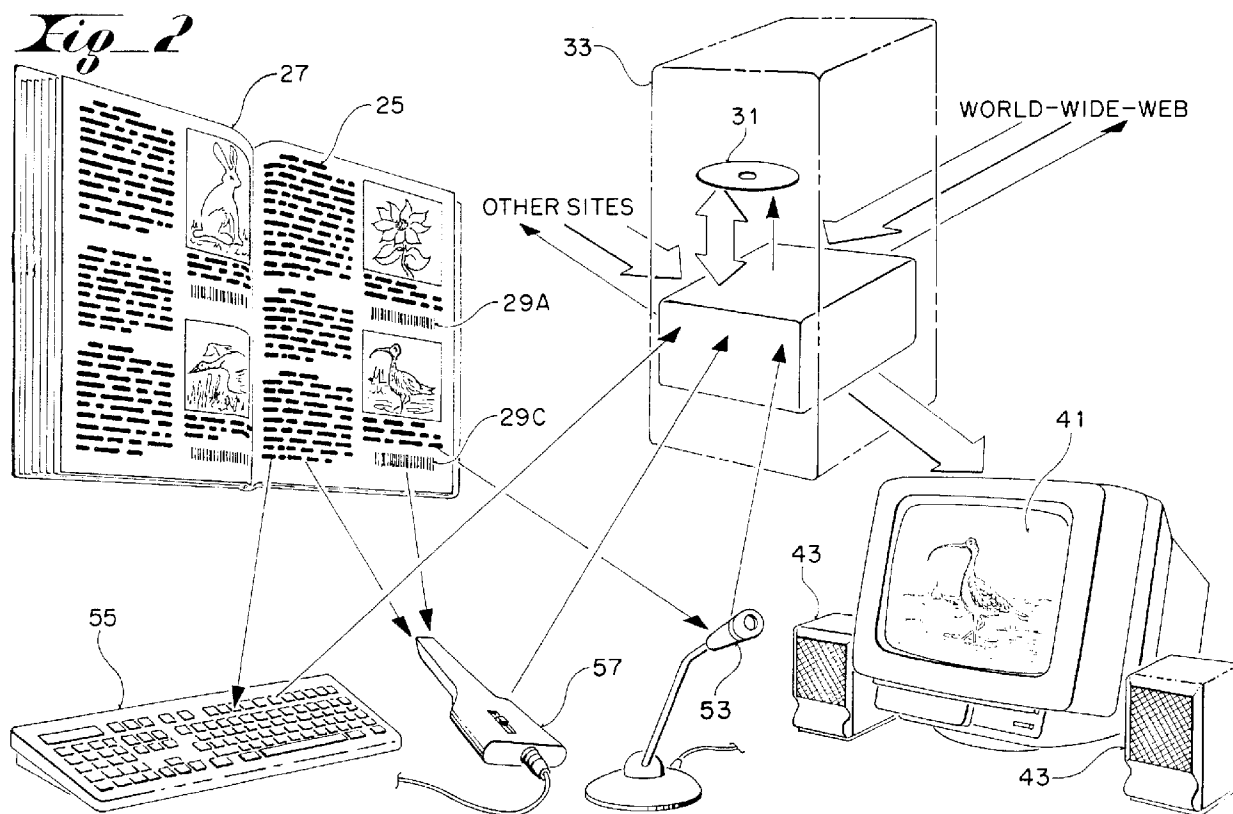
applicant respectfully requests previous discussions regarding the distinctions of these claims be applied to rejections for claim 32-38 (now 69-75).

The Office Action further rejects claims 7 and 15 (now 45 and 53) under 35 U.S.C. §103(a) as being unpatentable over Blume in view of Williams et al. (U.S. 5,899,700; hereinafter Williams).

Particularly, the Office states “Regarding claims 7 and 15, Blume discloses optical scanner 34 and describes it as being similar to bar code readers and other optical scanning devices that are well known. See ¶28. Although implied, Blume does not explicitly disclose that the coded indicia comprise barcodes.”

The Office introduces Williams for using bar code scanning. Particularly, “...Williams teaches a method and apparatus for providing multimedia material in response to a user scanning barcodes of a book. See Williams, col. 3, lines 3-27.”

While Williams identifies a standard bar code scanner in col. 3, lines 3-27 and as bar code reader 57 in Figure 2 shown below, there is no teaching, mention, or depiction of Applicant’s Electronic Reader that controls a Track Selection Wand/transmitter.



Williams Figure 2 (above)

Next, the Office states that “Thus, in view of Williams, it would have been obvious to modify the optical scanner and coded indicia described in Blume, by providing coded indicia in the form of barcodes, in order to retrieve supplemental multimedia information for a book.” As explained above, it would have violated Blume’s objective of using virtually invisible grids to place conspicuous bar codes on a page. Furthermore, modification of Blume by incorporating bar codes would not produce Applicant’s invention providing “an electronic indicia reader of the contents of said coded indicia, including identification of the selected book passage, identification of the corresponding selected track, and a control signal instruction for the transmitter to signal playback of the selected coded track...”.

Applicant's remarks and arguments from previous office action responses and submissions dated May 28, 2004, September 9, 2004, October 7, 2004, February 23, 2006, May 23, 2008, July 3, 2008, and April 29, 2009 are herein incorporated in their entirety by reference.

For at least the reasons detailed herein, the 35 U.S.C. §103(a) obviousness rejections for all the claims are traversed by the explanations provided herein. Applicant reserves the rights to make further arguments concerning other statements by the Office with respect to the cited references.

Applicant has carefully considered the Office rejections and respectfully submits that independent base claims 1, 8, 9, 20, 23 and 32 (now 39, 46, 47, 58, 61 and 69) are distinguishable from the cited references and are therefore allowable. Claims 2-7 (now 40-45) depend from independent base claim 1 (now 39), claims 10-19 (now 48-57) depend from independent base claim 9 (now 47), claims 21-22 (now 59-60) depend from independent base claim 20 (now 58), claims 24-30 (now 62-68) depend from independent base claim 23 (now 61), claims 33-38 (now 70-75) depend from independent base claim 32 (now 69). No new matter is added.

Applicant submits that claims 39-75 are patentably distinct over the cited references, whether alone or in combination. Review and allowance of the independent claims and their respective dependant claims is requested.

Applicant believes the above amendments and remarks to be fully responsive to the Office Action, thereby placing this application in condition for allowance. No new matter is added. Applicant requests speedy reconsideration, and further requests that Examiner contact its attorney by telephone, facsimile, or email for quickest resolution, if there are any remaining issues.

Respectfully submitted,

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